

Application No.: 10/809,796

AMENDMENT TO THE DRAWING

Attached hereto is a replacement drawing for Figure 9 which address the Examiner's objection thereto.

REMARKS

Claims 1 and 4 stand rejected under 35 U.S.C. § 102 as being anticipated by JP '611; claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over JP '611 in view of Farnworth et al.; and claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over JP '611 in view of Eldridge et al.. In order to expedite prosecution, claims 1-4 have been canceled without prejudice or disclaimer to the subject matter embodied thereby, and have been replaced with new claims 5-12. Claims 5 and 11 are independent.

Each of claims 5 and 11 embody a plurality of internal circuits, a first I/O cell including a first and second electrode portion, a second I/O cell including a third electrode portion, and an interlayer insulating film formed on the plurality of internal circuits, the first I/O cell and the second I/O cell and exposing the first electrode portion as a probing pad, the second electrode portion as a first terminal pad and the third electrode portion as a second terminal pad. The cited prior art appears to be completely silent as to such a novel combination of elements in the specified arrangement.

JP '611 appears silent as to an interlayer insulating film, let alone one arranged in the manner recited in claims 5 and 11 relative to the combination and arrangement of elements defining the respective first and second I/O cells. Farnworth et al. and Eldridge et al. are relied on by the Examiner merely for allegedly disclosing a DRAM and fuse element, respectively, and do not appear to overcome the deficiencies of JP '611 in relation to the novel *combination* of elements recited in claims 5 and 11.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a

single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that the cited prior art does not anticipate claims 5 and 11, nor any claim dependent thereon. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the cited prior art does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 5 and 11 because the cited prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 5 and 11 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.


CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

for  #46,692
Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MEF:men
Facsimile: 202.756.8087
Date: June 27, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**